

REMARKS

Claims 1-14 and 20-25 are pending in the application.

Claims 1-14 have been amended to correct grammar and to put the claims in better format. Claims 1 and 8 have been further amended to specify that the first and second panels form lower and upper panels respectively to provide a composite panel having a substantially planar upper surface for use as a vehicle panel in areas where a lightweight, strong, composite panel having at least one generally planar surface is desirable, such as for use as a tonneau cover, floorboard, door panel, roof panel and the like. Those claims have also been amended to clarify that the peripheral lip of the lower panel fits snugly against and within the peripheral lip of the upper panel both to help secure the panels together and to provide an aesthetically solid and uniform outer look to the upper surface of the composite panel when in use. Support for the amendments to claims 1 and 8 may be found in the specification, at least, at paragraphs [0028] – [0029].

In addition, new claims 20-25 have been added which depend from either claim 1 or claim 8. Claims 20-23 specify that the composite panels formed in accordance with the claimed methods are, in the embodiments noted, either a tonneau cover, a vehicle floorboard, a door panel or a roof panel. Claims 24-25 specify that the peripheral lips of the upper and lower panels form downturned edges such that they are depending lips. Support for new claims 20-23 may be found in the specification, at least, at paragraph [0027]. Support for new claims 24-25 may be found in the specification, at least, at paragraphs [0028] – [0029]. No new matter has been added by these amendments.

The Examiner has rejected claims 1-2, 5-10 and 13-14 under 35 U.S.C. §102(e) based on U.S. Patent No. 6,739,673 of Gupta et al. (“Gupta”) and claims 3-4 and 11-12 under §103(a) based on Gupta for the specific reasons noted in detail below.

Applicants traverse the Examiner’s §§102(e) and 103(a) rejections of claims 1-14 as specified above and the arguments in support thereof, and request reconsideration and withdrawal of the rejections.

Claim Rejection Under § 102(e) Based on Gupta

The Examiner has rejected claims 1-2, 5-10, and 13-14 under § 102(e) as unpatentable over Gupta. The Examiner has alleged that Gupta teaches all of the elements of the claimed

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invention including making a composite panel comprising forming a first panel 14/14' having a peripheral lip and a plurality of raised projections 42/42' (or reinforcements 20) having any of a variety of configurations, including convolutions, defining coplanar surfaces, forming a second panel 16/16' having a substantially planar surface and a peripheral lip, elongate projections 48 having a height less than projections 42, applying an adhesive 18/18' to at least the coplanar surfaces of the first panel, the first and second panels being formed of a thermoformable material, and securing the second panel to the first panel with the peripheral lips in substantial proximity.

In order to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim element is contained in a single prior art reference. Gupta does not meet this requirement.

Gupta is directed to automotive seat panels that have specific properties for reinforcement and use as a backseat. It is not important in Gupta what the configuration of the reinforcing structures are, so long as they help the panel to achieve properties required for automotive seats and provide a basis for attachment of seat hinges. Gupta does not teach forming an upper planar panel and a lower panel having raised projections as in claim 1 or raised features as in claim 2, wherein each panel has a peripheral lip configured so that the peripheral lip of the lower panel fits snugly against and within the peripheral lip of the upper panel, so that in use, the panel has at least one planar upper surface and smooth outer side surfaces suitable for the preferred intended uses.

Further, Gupta does not teach many of the dependent features, including, for example, downturned peripheral lips such that adhesive may be easily applied along the lower peripheral lip, or forming a panel that may be used as a tonneau cover, vehicle floorboard door panel or roof panel.

Therefore, Applicants respectfully submit that the rejection of claims 1-2, 5-10 and 13-14 based as anticipated by Gupta should be withdrawn.

Claim Rejection Under §103(a) Based on Gupta

The Examiner has rejected claims 3-4 and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over Gupta, as applied to claims 1 and 8 above. The Examiner has further alleged that regarding claim 3 and 4, one of ordinary skill in the art reading Gupta as a whole would have appreciated that the reference is not limited to a particular design, shape, pattern, etc. for the

projections, and in fact, states that just about any design, shape, pattern, etc. can be used. The Examiner has alleged that the selection of a particular design, shape, pattern, etc. for the projections would have been within the purview of the skilled artisan with Applicants' claimed shapes and patterns being well within the skill of the artisan. The Examiner has alleged that regarding claims 11 and 12, all the limitations were addressed with respect to claims 3-4.

Applicants respectfully traverse this rejection. There are three requirements that must be met in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a) based on a single reference. There must be some suggestion or motivation in the prior art to modify the reference as suggested by the Examiner. The prior art must further provide a basis for a reasonable expectation of success resulting from any such suggested modification of the cited reference. Finally, the prior art reference, as allegedly modified, must teach or suggest all elements of the claimed invention. The teaching or suggestion to make the claimed modification and the reasonable expectation of success must both be found in the prior art, and not based on the applicants' disclosure. See M.P.E.P. §§ 2142-43 (August 2004).

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify Gupta to provide the particular configurations of claims 3-4 and 11-12 in order to successfully make the invention of those claims, because the claimed invention is designed for a different purpose than the seating system of Gupta. Thus, raised structures that may be suitable to meet the particular criteria applied to the seating panels of Gupta are not necessarily the same raised structures that work in a different composite panel, such as a panel intended for use as a tonneau cover, roof panel, door panel or vehicle floorboard. As a result, Gupta's teachings do not lead one of ordinary skill in the art to select projections that are coplanar on the lower surface, and if a second plurality of projections is made, their height is lower than that of the coplanar projections. While such characteristics are important in forming the composite panels of the claimed invention, Gupta teaches just the opposite – that it is not important what features you use so long as sufficient strength for acting as a vehicle seat is achieved.

Applicants' invention is not directed to configured vehicle seats that can receive components or curve against the user's spine, and which meet specific vehicle seating requirements. Instead, the panels are lightweight, strong panels that have planar upper surfaces

and convoluted or raised projection lower surfaces as noted to provide a planar strong composite for particular uses within a vehicle that require a generally planar upper surface, strength, but reduced weight.

The panels of the claimed invention are also designed so as to be useful in certain applications, such as for use as a tonneau cover, roof panel or door panel, in an outside environment, exposed to the elements, including ambient extremes of temperature as well as heating from the sun and weight from heavy snow (see specification, Paragraphs [0004] – [0005]). The seating system of Gupta is designed to be placed or used in an interior vehicle system inside of a vehicle, to meet vehicle seat design configurations, including curved surfaces and specific physical properties, and does not take the same design criteria into account and so would not suggest such modification or provide a reasonable expectation of success as the Examiner has suggested (see, Gupta, col. 16, lines 56-65). The design approach and criteria for the seating system of Gupta would be different than those taken into account in making the claimed invention, and therefore, one of ordinary skill in the art would not look to Gupta for specific structural reinforcement designs *per se*.

In addition, as noted above, Gupta, even if modified as suggested by the Examiner to have the design features of claims 3-4 and 11-12, would still not teach or suggest all elements of the invention for the reasons set forth in response to the Examiner's §102(e) rejection.

Therefore, applicants submit that the Examiner has not established *prima facie* obviousness based on Gupta for claims 3-4 and 11-12 and request reconsideration and withdrawal of the rejection based on §103(a).

Finally, applicants submit that even if *prima facie* obviousness had been shown, which applicants maintain it has not, applicants' composite panels provide a long-felt need in the art for lightweight composite panels that are sufficiently strong and provide an upper generally planar surface and smooth exterior appearance on the sides of the panel for use in exterior and other surfaces of a vehicle which are subject to exterior conditions and/or significant wear such as vehicle floorboards, tonneau covers, door and roof panels. Therefore, Applicants respectfully submit that any such *prima facie* obviousness, is overcome by the uniqueness of the applicant's invention, and withdrawal of the rejection is respectfully requested.

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In view of the foregoing, applicants submit that claims 1-14 as well as newly added claims 20-25 are patentable over Gupta. Reconsideration and withdrawal of the rejections, and a Notice of Allowance are respectfully solicited.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (in duplicate)